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December 5, 2003

TO (FIRM): United States Patent And Trademark Office, Group Art Unit: 1745
ATTN: Examiner: R. Alejandro

FAX NO.: 703-872-9306

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FROM: James G. McEwen

Re: U.S. Patent Application
Serial No.: 10/092,300
For: POSITIVE ACTIVE MATERIAL COMPOSITION FOR RECHARGEABLE
LITHIUM BATTERIES
Inventor: Ho-Jin KWEON, et al.
Our Docket: 1567.1027

NO. OF PAGES (Including this Cover Sheet)

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COMMENTS:

RESPONSE TO RESTRICTION REQUIREMENT

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mitted via facsimile to: Commissioner for Patents,
P.O. Box 1450, Alexandria, VA 22313-1450
on Dec 5, 2003
By: STAAS & HALSEY
Date: Dec 5, 2003

Docket No.: 1567.1027

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Ho-Jin KWEON, et al.

Serial No. 10/092,300

Group Art Unit: 1745

Confirmation No. 2618

Filed: March 7, 2002

Examiner: R. Alejandro

For: POSITIVE ACTIVE MATERIAL COMPOSITION FOR RECHARGEABLE LITHIUM BATTERIES

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RESPONSE TO RESTRICTION REQUIREMENTCommissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed November 5, 2003, having a shortened period for response set to expire on December 5, 2003, the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect Group I (claims 1-6, 10-24, and 32-35) in response to the preliminary restriction requirement set forth in the Office Action.

Additionally, applicants provisionally elect Species 1. In view of the Examiner's definition, it is believed that Species 1 includes at least claims 1-6, 10-14, 24, and 33.

Moreover, the Examiner states on page 3 of the Office Action that claim 1 appears to be generic to the Species. However, it is respectfully submitted that claims 2-6 are further considered generic to Species 1 through 4 as not being limited to a type of thermal absorbent element or the use of additional additive compounds, which the Examiner has used to define the Species. Similarly, it is respectfully submitted that claims 10-14, 24 and 33 are generic to Species 1 through 4.

II. Applicants Traverse the Requirement

Insofar as Group II is concerned, it is believed that claims 7-9 and 25-31 are so closely related to elected claims 1-6, 10-24, and 32-35 that they should remain in the same application to avoid imposing any undue burden, expense, and delay on the Applicants in preserving the

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invention recited in claims 7-9 and 25-31. There have been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing both method and product claims in the same field of technology. While it is noted that the Examiner has identified different classifications for the product and method claims, it is believed that classification is not conclusive on the question of restriction.

Additionally, while the Examiner asserts that the applicants' have made various admissions as to the invention, the Examiner does not rely on specific statements in the specification which would appear to qualify as an admission. C.f., MPEP 2129 (defining an admission in the context of prior art admissions), and MPEP 1412.01 (defining invention in terms of evidence in specification for purposes of reissue). As such, it is respectfully submitted that, even assuming arguendo that the Examiner is correct as to the number of different methods that can be used, the source of the evidence is not the instant application.

Of the elected claims 1-6, 10-24, and 32-35, at least claim 5 recites "said additive compound is prepared by drying a liquid comprising a thermal-absorbent element or a thermal-absorbent element-included compound at a temperature ranging from at or between room temperature and 200°C for at or between 1 and 24 hours." In addition, of the non-elected claims, at least claim 7 recites, among other features, "drying a thermal-absorbent element or a thermal-absorbent element-included-compound at a temperature ranging from at or between room temperature and 200°C for at or between 1 and 24 hours to prepare an additive compound, the additive compound being selected from the group consisting of a thermal-absorbent element-included hydroxide, a thermal-absorbent element-included oxyhydroxide, a thermal-absorbent element-included oxycarbonate, and a thermal-absorbent element-included hydroxycarbonate." As such, it is believed that the Examiner's search in regard to at least claim 5 would naturally encompass both method and product technologies.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)-§806.04(i), §808.01(a) and §808.02). As such, beyond showing separate classifications, it is respectfully submitted that the Examiner has not set forth sufficient evidence to show that the Examiner will experience a serious burden without imposing restriction which is out of proportion with the serious burden and inconvenience visited upon the applicants if restriction is required.

On pages 3-4, the Examiner asserts that applicants must elect between species drawn to

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a Al or B per se (Species 1), an Al-included hydroxide by itself (Species 2), a B-included hydroxide as such (Species 3), and another additive compound (Species 4). As noted in MPEP 806.04(a), "37 CFR 1.141 provides that a *reasonable number of species* may still be claimed in one application if the other conditions of the rule are met" (*italics added*). Consistent with the requirements in MPEP 803 and 808, the Examiner needs to provide a rationale as to why an election is required or how, without the election, the Examiner is unduly burdened in comparison with the burden visited on the applicants in the extra delay and expense in obtaining protection for each Species.

In the Office Action, the Examiner has not provided evidence that the Examiner will experience an undue burden in searching and examining the invention set forth in Species 1 through 4. Specifically, the Examiner has not provided evidence that the existence of four species represents an unreasonable number of species to be searched, and has not provided a rationale as to why the invention is to be separated into Species 1 through 4.

It is further respectfully believed that, in searching the technologies related to the Species 1, the Examiner would encounter the features of Species 2 through 4 if they are available in the prior art. As such, it is respectfully submitted that the Examiner has not presented sufficient evidence of a burden on the Examiner in examining Species 1 through 4 which is out of proportion with the delay and expense visited on the applicants in protecting the invention recited in Species 2 through 4 so as to show an undue burden on the Examiner or an unreasonable number of species so as to also require an election between these species. As such, it is respectfully requested that the Examiner reconsider and withdraw the election.

III. Conclusion

Upon review of references involved in this field of technology, when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

If any further fees are required in connection with the filing of this Response, please charge the same to our deposit account number 19-3935.


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Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

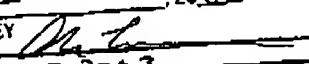
Respectfully submitted,

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